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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,353	11/27/2001	Sam E. J. Chan	3068	3120

27727 7590 12/04/2002

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EXAMINER

WARD, JOHN A

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996,353

Applicant(s)

CHAN ET AL.

Examiner

John A. Ward

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: _____

DETAILED ACTION***Claim Objections***

Claim 19 is objected to because of the following informalities: it is unclear whether the second comprise should be comprises or comprising. Appropriate correction is required. Assuming that the second comprise should be comprising the follow rejection regarding claim 19 is discussed below.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10, and 16-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-7, 10, 12, 14, 27 and 29 of U.S. Patent No. 6,332,229. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is disclosed and covered in the Patent ('229) as shown in the chart below.

Art Unit: 2875

Claims:

Instant Application	Patent ('229)	Discussion or Differences
Claim 1	Claim 29	Claim 1 of the instant application is broader in scope than the scope of the patented claim 29, which includes a plurality of key switches, each having a cap and stem portion, and a panel that emits light directly up through the keyboard.
Claim 2	Claim 27	Claim 2 of the instant application is incorporated in patented claim 27.
Claim 3	Claim 29	Claim 3 of the instant application is incorporated in patented claim 29.
Claim 4	Claim 2	The limitation of each claim is identical.
Claim 5	Claim 3	The limitation of each claim is identical.
Claim 6	Claim 4	The limitation of each claim is identical.
Claim 7	Claim 5	The limitation of each claim is identical.
Claim 8	Claim 6	Chan et al discloses substantially all the limitation of the claims except for the caps is translucent. It would have been obvious to one of ordinary skill in the art at the time the invention was to make the indicia translucent, since it has been held to be within the general skill of a worker in the art to select known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.
Claim 9	Claim 7	The limitation of each claim is identical.
Claim 10	Claim 8	The limitation of each claim is identical.
Claim 15	Claim 9	The limitation of each claim is identical.
Claim 16	Claim 16	Claim 16 of the instant application is incorporated in the patented claim 16
Claim 21	Claim 10	Claim 21 of the instant application is substantially the same of claim 10.
Claim 22	Claim 10	Claim 21 of the instant application is substantially the same of claim 10.

Claim 23	Claim 10	Claim 21 of the instant application is substantially the same of claim 10.
Claim 24	Claim 14	Claim 24 of the instant application is incorporated in the patented claim 14
Claim 25	Claim 13	The limitation of each claim is identical.
Claim 26	Claim 14	The limitation of each claim is identical.

Claims 27-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,322,229. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is disclosed and covered in the Patent ('229) as shown in the chart below.

Claims:

Instant Application ('353)	Patent ('229)	Differences
Claim 27	Claim 29	Claim 27 of the instant application is incorporated in the patented claim 29.
Claim 28	Claim 28	The limitation of each claim is identical.

Claims 33 and 34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 28 and 29 of U.S. Patent No. 6,322,229 in the chart below. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter

Art Unit: 2875

claimed in the instant application is disclosed and covered in the Patent ('229) as shown in the chart below.

Claims:

<i>Instant Application</i> <i>('353)</i>	<i>Patent</i> <i>('229)</i>	<i>Difference</i>
<i>Claim 33</i>	<i>Claim 29</i>	<i>Claim 27 of the instant application is incorporated in the patented claim 29.</i>
<i>Claim 34</i>	<i>Claim 28</i>	<i>The limitation of each claim is identical.</i>

Claims 11, 29, and 35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 29 of U.S. Patent No. 6,332,229 in view of Katrinecz, Jr. et al (US 6,199,996). Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is disclosed and covered in the Patent ('229) in view of ('996) as shown in the chart below.

Claims:

<i>Instant Application</i>	<i>Patent</i> <i>('229)</i>	<i>Differences in view of ('996) Claim 5.</i>
<i>11</i>	<i>1</i>	<i>An intensity control device to control the amount of illumination from the light source.</i>
<i>29</i>	<i>29</i>	<i>An intensity control device to control the amount of illumination from the light source.</i>

35	29	<i>An intensity control device to control the amount of illumination from the light source.</i>
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Therefore it would have been obvious to one of ordinary skill in the art at the time to combine the keyboard of Chan et al with the keyboard having an intensity control device Katrinecz, Jr. et al, in order to provide a means that can be controlled by the user and may vary in response to the background light of the environment as taught Katrinecz, Jr. et al (abstract).

Claims 12, 30 and 36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 29 of U.S. Patent No. 6,322,229 in view of Fenner (US 5,997,901). Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is disclosed and covered in the Patent ('229) in view of ('901) as shown in the chart below.

Claims:

Instant Application	Patent ('229)	Differences in respect to Claim 6 of ('901).
12	1	Includes control means to shut off the light switch over a period of time on inactivity.
30	29	Includes control means to shut off the light switch over a period of time on inactivity.
36	29	Includes control means to shut off the light switch over a period of time on inactivity.

Therefore it would have been obvious to one of ordinary skills in the art at the time the invention was made to combine the illuminated keyboard of Chan et al with a keyboard having a shut-off control of Fenner in order to provide a means to operate the keyboard in a darken room as taught by Fenner (abstract).

Claims 13, 31 and 37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, and 29 of U.S. Patent No. 6,322,229 in view of Novak (US 6,357,887). Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is disclosed and covered in the Patent ('229) in view of ('887) as shown in the chart below.

Claims:

Instant Application	Patent ('229)	Differences in respect to claim 7 of Patent ('887).
13	1	Includes a touch pad with means of illumination.
31	29	Includes a touch pad with means of illumination.
37	29	Includes a touch pad with means of illumination.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the illuminated keyboard of Chan et al with the housing that houses a keyboard of Novak in order to provide a means of an improved housing with one of a illuminable connector as taught by Novak (abstract).

Claims 14, 32 and 38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, and 29 of U.S. Patent No. 6,322,229 in view of Novak (US 6,357,887). Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is disclosed and covered in the Patent ('229) in view of ('887) as shown in the chart below.

Claims:

Instant Application	Patent ('229)	Differences in regard to patent ('887) see column 4, lines 14-22.
14	1	Includes a right and left control.
32	29	Includes a right and left control.
38	29	Includes a right and left control.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the illuminated keyboard of Chan et al with the housing that houses a keyboard of Novak in order to provide a means of an improved housing with one of a illuminable connector as taught by Novak (abstract).

Allowable Subject Matter

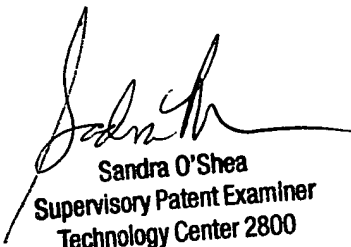
Claims 17-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. Ward whose telephone number is 703-305-5157. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 703-305-4939. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0596.

JAW
December 1, 2002


Sandra O'Shea
Supervisory Patent Examiner
Technology Center 2800